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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,712	06/23/2003	Michael Francis Dube	14150-00601	5751

25243 7590 06/28/2005

COLLIER SHANNON SCOTT, PLLC  
3050 K STREET, NW  
SUITE 400  
WASHINGTON, DC 20007

EXAMINER

WALLS, DIONNE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/600,712

Applicant(s)

DUBE ET AL.

Examiner

Dionne A. Walls

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1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4-11-05.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 and 35-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 15-22, 41-44, 46-48 and 54-59 is/are rejected.
- 7) ☒ Claim(s) 9, 13, 14, 30, 33, 45 and 60 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 59 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 59 recites the limitation "the filter rod". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8, 10-12, 15-22, 41-44, 46-48, 54-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al (US. Pat. No. 3,599,646) in view of Marmo (US. Pat. No. 4,311,720).

Berger et al discloses nearly all that is recited in the claims, since it teaches a tobacco rod 22, and a filter element 20 connected to said rod. The filter element 20 has an inner member 36, comprised of a filter material which may be cellulose acetate, which has a cavity 48 which can be configured such that it faces/is exposed to the tobacco rod 22. The filter has all of the structural elements recited in the claims, either

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as explicitly stated, represented by the figures or inherently. While Berger may not specifically state that at least one breakable capsule is disposed in the cavity, it does state that materials for flavoring smoke may be provided in the cavity (see col. 1, lines 54-58). Further, Marmo et al discloses a means to flavor tobacco smoke comprising gelatin, flavor-filled capsules (which obviously can be considered to be "breakable") that have the claimed characteristics. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the flavoring means of Marmo et al into the filter cavity of Berger et al since the flavor capsules of Marmo et al provide for instantaneous evenly distributed flavor release during smoking activity (see col. 4, lines 40-52).

Regarding claims 11-12, 31-32, 42-43, and 46, while Berger et al modified by Marmo et al may not specifically state that a diluting agent is used, with the flavorant, and said agent is a medium chain triglyceride, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide for a diluting agent, in the form of such a triglyceride mixture, since this type of oily substance is capable of readily dissolving hydrophobic flavorants, is excellent in oxidation stability and is easy to handle due to its low viscosity, which would allow for a more homogenous mixture to be used in the flavor-contained gel of the combined references.

Regarding claims 47-48, since the filter segment of Berger modified by Marmo is the same, structurally, as that of the instant invention, it follows that it would also be capable of exhibiting the same characteristic of decompressing/attaining a functional shape after compressing.

***Allowable Subject Matter***

6. Claims 9, 13-14, 30, 33, 45 and 60 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

7. Applicant's arguments filed 4/11/2005 have been fully considered but they are not persuasive.

- Applicant argues that, in Berger, the cavity 48 does not have an open end that meets the end of the tobacco rod, so said cavity does not extend from the "proximal end of the filter element". However, the Examiner disagrees. First, Applicant has not claimed that the open end "meets the end of the tobacco rod". Further, it is clear that Berger et al envisions such an arrangement since it states, in col. 2, lines 21-23, that the position of the filter may be reversed, from that shown in the drawings, so that the cavity 48 faces the tobacco rod 22, which the Examiner has also interpreted as meaning "exposed to/abutting" the tobacco rod. (It is clear that under this arrangement, there would be no need for disk 50 serving to retain the flavoring material). Therefore, this teaching corresponds to the related limitations in the claims.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

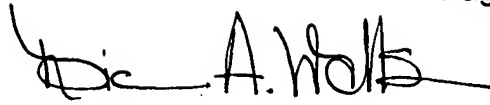
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dionne A. Walls

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A handwritten signature in black ink, appearing to read "A. Holt". The signature is stylized with a large, looped initial "H" and a long horizontal stroke extending to the right.

Primary Examiner  
Art Unit 1731

June 25, 2005